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DETAILED ACTION

Claims 1-20 are pending.

Claims 1-7, 9, 11-19 are under consideration.

Claims 8, 10 and 20 are non-elected and withdrawn at this time.

Applicants had elected Group I of the restriction without traverse in paper filed 9/8/11.

Group I is drawn to Claims 1-7 and 9, directed to compounds and compositions of formula I wherein R^2 , R^3 , R^4 , A--A4, and B--B4 are each independently H, an optionally substituted alkyl, halogen, alkoxy, cyano, or haloalkyl, and none of which form a ring together (including R4a-d), Y is a bond or C=O and R^1 is not a H.

The claims still contain non-elected subject matter.

Applicants should amend the claims to the elected scope.

The rejections under 35 USC 102 independently over

Caplus English abstract AN 1952:57258 , Kretz E et al.

Caplus Englis abstract Ono Keiichi et al.

US 4307235 Henlen Ong et al.

Meng Hsin Chen.

WO 9429309

And WO 03/106457 have been withdrawn as applicants claims have a proviso that the

A' s and B substituents cannot be a H at the same time.

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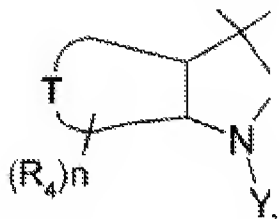
The non statutory ODP over 10/581174 still stands. The argument that p and q is the prior art cannot both be 2 and hence the N cannot be at the para position. This would make it a positional isomer and with every thing being the same positional isomers are prima facie obvious. A compound that differs only in molecular arrangement from the compounds disclosed in the prior art and which for which no unexpected properties of this compound are disclosed in the specification is unpatenable, *Ex parte KRUEGER AND HAYES*, 121 USPQ 420, *In re NORRIS*, 84 USPQ 458, *In re Hass* 60 USPQ 552, which found a *prima facia* case of obviousness of 1-chloro-1-nitrobutane over 1-chloro-1-nitroisobutane taught in the prior art, *Ex parte Ullyot*, 103 USPQ 185, which found a *prima facia* case of obviousness of 2-oxo-quinolines over a 1-oxo-isoquinoline taught in the prior art, *In re FINLEY*, 81 USPQ 383 , which found a *prima facia* case of obviousness of 2-ethyl hexyl salicylate over octyl salicylate taught in the prior art.

The rejection under ODP over 10/517957 has been withdrawn as this application has been abandoned.

However applicants have filed a new application 13/234793 wherein there are compounds with R9 and R10 are halogen or alkyl groups.

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The rejection under ODP over US patent US 7.960,401 has also been withdrawn as the



T ring is a hetero aromatic ring and contains a N atom.

Thus the core is different.

The rejection of the claims over 102 (e) over Huges et al has been withdrawn as applicants have provided a statement of commom ownership.

The rejection over WO 03/106457 under 102 (a has been withdrawn as applicants have an earlier priority date.

The New ODP rejection will be made on 13/234793 on the newly added claim 20 if rejoined.

New Rejection :-

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

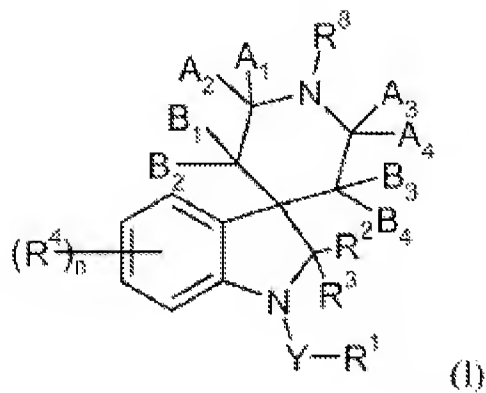
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Claims 1-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono

GB 10603030

US 4307235 Helen Ong et al.

Applicants claims are drawn to compounds of the formula



with a proviso that one of A1, A2, A3, A4 or

B1, B2, B3 or B4 is other than a hydrogen

“provided that when B1, B2, B3 and B4 are all H, either both A~ and A2 are different from H or both A3 and A4 are different from H.

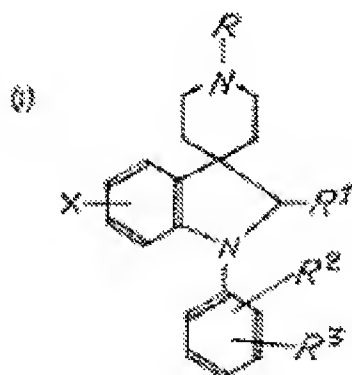
“

Scope & Content of Prior Art MPEP 2141.01

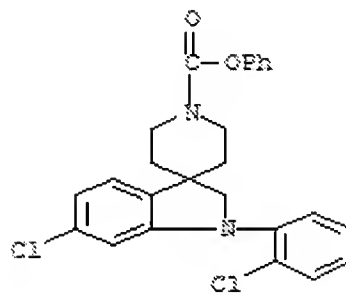
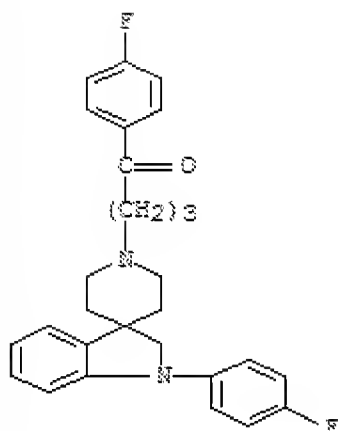
The prior art reference all teaches compounds with a similar scope. See the previous 102 b references.

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Ono GB 10603030 also teaches the general formula



some species taught are

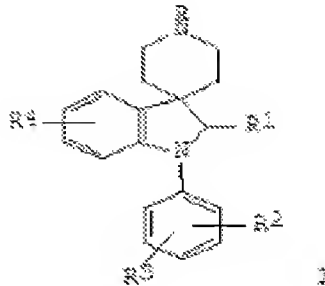


. These are

just some of the species.

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Ong teaches



The reference discloses

which reads

on the applicants compounds when Y is a bond, R1 is a phenyl (aryl) and R = H, alkyl,

cyano, alkanoyl, CO2Ph, phenylalkyl, phenylalkanoyl, alkenyl,

cycloalkylalkyl, omega-benzoylalkyl (or its ethylene ketal

Difference between Prior Art and the claims MPEP 2141.02

The reference teaches very similar compounds. The difference is in the presence of a substituent at the A's or B's positions. Some of the species made in the specifications has a CH3 substituent.

This make the difference of a CH3 instead of a H.

The prior art reference also teaches the compositions .

Applicants intended use does not have any patentable weight.

Catalina Mktg. Int'l, Inc. V. Coolsavings.com, Inc., 289 F.3d 801,808, 62 USPQ2d 1781, 1785

(fed. Cir. 2002). "The recitation of a new intended use for an old product does not make a claim to that old product patentable." In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997~.

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Prima Facie Obviousness , Rational and Motivation MPEP 2142-2413

Very similar compounds are known. When chemical compounds have "very close" structural similarities and similar utilities, without more a prima facie case may be made. In re Wilder, 563 F.2d 457 (CCPA 1957). Stated alternatively, obviousness may be based solely upon structural similarity (an established structural relationship between a prior art compound and the claimed compound, as with homologs). See In re Duel, 51 F.3d 1552, 1559 (Fed. Cir. 1995). The necessary motivation to make the claimed compound, and thus the prima facie case of obviousness, arises from the reasonable expectation that compounds similar in structure will have similar properties. In re Gyurik, 596 F.2d 1012, 1018 (CCPA 1979).

Also see In re Wood. It is well established that the substitution of methyl for hydrogen on a known compound is not a patentable modification absent unexpected or unobvious results. In re Wood, 199 U.S.P.Q. 137 (C.C.P.A. 1978) and In re Lohr, 137 U.S.P.Q. 548, 549 (C.C.P.A. 1963). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess some activity. Applicants claims are drawn to compounds rather than to a method of use. The compounds have a very close structural similarity. The compounds in table 1 , wherein B1 is a CH₃.

There is no side by side comparison that that prior art compounds would not be expected to have the same activity. Discovery of a new use of same compounds does not make the compounds patentable.

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Conclusion

Claims 1--9 , 11-19 are rejected.

Claims 10 and 20 are drawn to a non-elected invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RITA DESAI whose telephone number is (571)272-0684.

The examiner can normally be reached on Maxi- flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rita J. Desai/
Primary Examiner, Art Unit 1625

February 6, 2012.